

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL W. PEARSON

Appeal No. 96-4010
Application 29/021,122¹

ON BRIEF

Before COHEN, ABRAMS and FRANKFORT, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed April 11, 1994. This application is a continuation-in-part of Application 07/990,789, filed May 27, 1993, abandoned.

Appeal No. 96-4010
Application 29/021,122

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of the following design claim:

The ornamental design for a CORN SAVER SHIELD
as shown and described.

As explained in appellant's originally filed design specification, the invention for which design patent protection is sought is a "new, original and ornamental design for a CORN SAVER SHIELD." A first embodiment of this invention is found in Figures 1 through 6 of the drawings and a visually different second embodiment is seen in Figures 7 through 12. In appellant's response (Paper No. 3, filed June 27, 1994) to the examiner's request for information (Paper No. 2), it was explained that the invention herein is directed to a design for a corn saver shield which is used on a corn header, such as that shown in U.S. Patent No. 3,241,299 to R. L. Sutton. Apparently, similar to the gathering sheets (21) in Sutton and, more particularly, the ridges or shields designated (22), (23) and (24) therein, appellant's corn saver shield is to be mounted

Appeal No. 96-4010
Application 29/021,122

between the row units of a combine header and serves the purpose of minimizing corn ear loss by blocking the ears of corn if they

bounce out of the gathering chains or auger. On page 2 of the first Office action (Paper No. 5, mailed March 10, 1995), the examiner has made the determination that the two embodiments seen in the present application "present overall appearances that are not distinct from one another" and that the two embodiments thus "comprise a single inventive concept." On the record before us, it does not appear that appellant has traversed this determination. Accordingly, the two embodiments have been retained and examined in this single application.

There are no prior art references relied upon by the examiner in the rejection before us on appeal. Instead, the examiner has asserted that appellant's design does not meet the requirements of 35 U.S.C. § 171.

The appealed design claim stands rejected under 35 U.S.C. § 171 as "lacking ornamentality." More particularly, it is the examiner's position that

Appeal No. 96-4010
Application 29/021,122

[t]he instant article is believed to be devoid of ornamentality, as comprehended by the statutes. Articles of this type would seem to be devised to satisfy purely structural and mechanical requirements as well. No concern for ornamental value may be ascribed to its functional features. A

potential purchaser and user of the claimed article would not select it on the basis of any consideration other than utility (answer, pages 2-3).

Reference is made to the examiner's answer (Paper No. 15, mailed June 11, 1996) for the examiner's full reasoning in support of the above-noted rejection. Attention is directed to appellant's brief (Paper No. 14, filed March 28, 1996) for an exposition of appellant's arguments thereagainst.

OPINION

Having carefully considered the issue raised in this appeal in light of the examiner's remarks and appellant's arguments, it is our conclusion that the examiner's rejection of the present design claim under 35 U.S.C. § 171 cannot be sustained. Our reasons for this determination follow.

Appeal No. 96-4010
Application 29/021,122

Like the examiner, we recognize that 35 U.S.C. § 171 permits a design patent to be granted for a "new, original and ornamental design for an article of manufacture." In this regard, the U.S. Supreme Court has noted that

[t]o qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability.

See Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 148, 9 USPQ2d 1847, 1851 (1989).

In In re Carletti, 328 F.2d 1020, 1022, 140 USPQ 653, 654 (CCPA 1964), the Court observed, in affirming the refusal of a patent on a design for an article, the configuration of which was determined to be the "result of functional considerations only," that

[m]any well-constructed articles of manufacture whose configurations are dictated solely by function are pleasing to look upon But it has long been settled that when a configuration is the result of functional considerations only, the resulting design is not patentable as an ornamental design for the simple reason that it is not

Appeal No. 96-4010
Application 29/021,122

"ornamental" -- was not created for the
purpose of ornamenting.

In other words, the design of a useful article is deemed to be functional or "primarily functional"² when the appearance of the

claimed design is inevitably dictated by the use or purpose of the article.

Our present Court of review has further spoken to the issue of ornamentality versus functionality on several occasions, noting in L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123, 25 USPQ2d 1913, 1917 (Fed. Cir.), cert. denied, 510 U.S. 908 (1993) that

[i]n determining whether a design is primarily functional or primarily ornamental the claimed design is viewed in its entirety, for the ultimate question is not the functional or decorative aspect of each separate feature, but the overall appearance of the article, in determining whether the claimed design is dictated by the utilitarian purpose of the article.

² See Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d 234, 238, 231 USPQ 774, 777 (Fed Cir. 1986).

Appeal No. 96-4010
Application 29/021,122

Also noted in L.A. Gear and Berry Sterling Corp. v. Pescor
Plastics Inc., 122 F.3d 1452, 1456, 43 USPQ2d 1953, 1956
(Fed. Cir. 1997), is the proposition that

[w]hen there are several ways to achieve the
function of an article of manufacture, the
design of the article is more likely to serve
a primarily ornamental purpose.

In Berry Sterling, 122 F.3d at 1456, 43 USPQ2d at 1956,
with regard to alternative designs, Judge Rich goes on to
indicate that

[c]onsideration of alternative designs,
if present, is a useful tool that may
allow a court to conclude that a challenged
design is not invalid for functionality. As
such, alternative designs join the list of
other appropriate considerations for
assessing whether the patented design as a
whole --- its overall appearance --- was
dictated by functional considerations. Other
appropriate considerations might include:
whether the protected design represents the
best design; whether alternative designs
would adversely affect the utility of the
specified article; whether there are any
concomitant utility patents; whether the
advertising touts particular features of the
design as having specific utility; and
whether there are any elements in the design
or an overall appearance clearly not dictated
by function.

Appeal No. 96-4010
Application 29/021,122

With the above as guidance, we have reviewed the positions of the examiner and appellant, and reached the conclusion that the overall appearance of the design for a CORN SAVER SHIELD before us on appeal is not dictated by function alone. As an initial observation, we are of the opinion that the mere presence in this application of two alternative designs, which are clearly visually different from one another, is evidence that the claimed design considered as a whole is not dictated by function alone or the result of functional considerations only.

Further, contrary to the views of the examiner, we find that the other prior art of record in this application (e.g., U.S. Patent numbers 2,366,408 (Jenson), 3,241,299 (Sutton), 3,520,121 (Ashton et al.) and 4,630,430 (Weeks)), demonstrates not only the existence of alternative designs, but also evidences that alternative designs would not adversely affect the utility of the specified article, and provides evidence that appellant's designs are not necessarily "the best design." As to the declarations submitted by appellant in this application (Paper Nos. 6 and 9) and the initial submissions (e.g., on December 9,

Appeal No. 96-4010
Application 29/021,122

1992) made in appellant's parent application Ser. No. 07/990,789, we view these papers collectively as demonstrating, from the time of earliest filing by applicant, that he had in mind considerations of both the design and function of the shield, and of the ornamentality and attractiveness of the corn saver shield and the corn header on which it was intended to be used. In the face of the evidence supplied by appellant, the examiner has provided no evidence or reasoning to support her conclusion that the claimed design is "devoid of ornamentality" or that potential purchasers and users of the claimed article "would not select it on the basis of any consideration other than utility" (answer, pages 2-3).

It follows from the above considerations that we view the present design as not being dictated by function alone and thereby to be proper subject matter for protection under 35 U.S.C. § 171.

Appeal No. 96-4010
Application 29/021,122

In accordance with the foregoing, the decision of the
examiner rejecting the claimed design under 35 U.S.C. § 171 is
reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

Appeal No. 96-4010
Application 29/021,122

Burd, Bartz & Gutenkauf
1300 Foshay Tower
Minneapolis, MN 55402